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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,937	10/07/2003	Thomas B. Stanford JR.	B-4588NP 620930-1	6021

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/680,937

Applicant(s)

STANFORD ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1655

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

1. Applicants' status inquiries for the instant application filed 14 October 2004, 7 March 2005, 29 September 2005 and 14 February 2006 is acknowledged and entered. In response to said "Non-Provisional U.S. Patent Applications Status Inquiries" an Office Action follows.
2. The correct Serial Number of your Non-Provisional U.S. Patent Application under prosecution at the United States Patent and Trademark Office (i.e., USPTO) is 10/680,937 per applicants' recitation in status inquiry filed 15 October 2004, not "Our reference Number 620930-1/AS" as recited in the Status Inquiry letter filed 14 February 2006. Please ensure that the correct U.S. Serial Number for this application (i.e., 10/680,937) is cited in all future correspondence with this Office.
3. Your application is assigned to Dr. Kailash C. Srivastava in Art Unit 1655 at the United States Patent and Trademark Office (i.e., USPTO). To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Kailash C. Srivastava in Art Unit 1655.

## **Claims Status**

4. Claims 1-17 are pending.

## ***Election /Restriction***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Group I, consisting of claims 1-13 drawn to a sensor, classified under Class 435, subclass 287.1, for example.
  - Group II, consisting of claims 14-17, drawn to a method to identify an organism, classified under Class 435, subclass 22, for example.

## ***Inventions are Independent and Distinct***

6. The inventions are distinct, each from the other because of the following reasons:

Invention in Group I is related to invention in Group II as a product/apparatus and use thereof. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product [MPEP

§ 806.05(h)). The method of inventions encompassed in Group II invention for example can be accomplished with a number of laboratory diagnostic tests generally known to one skilled (e.g., a microbiologist). Similarly, product of invention in Groups I would be applicable to determine presence of any enzyme or a microorganism in any sample (e.g., a food or beverage).

The inventions discussed above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (class and subclass), and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

### ***Species Election***

7. This application contains claims directed to a method encompassing different compositions comprised of a variety of ingredients. The search for each of the above inventions is not co-extensive, particularly with regard to the literature search. This is because of the fact that the inventive groups discussed above incorporate numerous compositions and numerous ingredients within each of the same, single composition. For example, to conduct a literature search for invention in Group II that is constituted of different enzymes, one would be searching for a total number of combinations that will be a factorial of at least 20 with each one of the ingredients up to ingredient number 1 (i.e.  $20 \times 19$ ,  $10 \times 18$ ,  $20 \times 17$ ,  $20 \times 16$  and up to---  $20 \times 1$ ). Thus, this group alone will exert an enormous search burden on the Examiner. Additional groups will be those listed in for e.g., Claim 14(d) to 14 (d) etc. The sum total of all the groups will be a number of geometrical proportions. Therefore, if the applicants elect Group I invention listed above, the applicant must also make election of species by electing a single species from each of the following categories:

- i. Only one of the encapsulating matrix listed in Claim 6;
- ii. Only one enzyme among those listed in Claim 8;
- iii. Only one reactant, and
- iv. Only one transducer.

If applicants elect the invention of Group III for invention, then applicants must make election of species by electing a single species from reach of the following categories:

- a. Only one enzyme among those listed in Claim 15; and
- b. Only one process product from those listed in Claim 16.

For example if the applicant elects for prosecution the method Group II, the applicant election statement should be. For e.g., "Applicant elects the invention in Group II to a method of identifying a microorganism that expresses  $\alpha$ -amylase and the process product as carbon dioxide.

8. If applicants elect any one of Groups I – II, the applicants are required under 35 U.S.C. §121 to elect a single disclosed species of composition, enumerating all ingredients therein for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1 and 14 are generic.

9. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR §1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species [MPEP § 809.02(a)].

Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.


10. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b) if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(I).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner

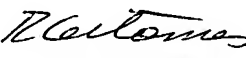
can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Kailash C. Srivastava, Ph.D.  
Patent Examiner  
Art Unit 1655  
(571) 272-0923

March 15, 2006

  
RALPH GITOMER  
PRIMARY EXAMINER  
GROUP 1200